

REMARKS

The present communication is responsive to the Office Action mailed September 23, 2008. A one-month extension of time is transmitted herewith extending the period of reply from December 23, 2008, up to and including January 23, 2009.

Claims 1-8 and 13-24 were rejected in the Action. Claims 1, 8, 17 and 20 have been amended and no claims have been canceled or added herein. Therefore, claims 1-8 and 13-24 remain pending in the present application. Support for all claim amendments can be found in Applicants' originally filed disclosure in at least paragraphs [00146]-[00147]. As such, no new matter has been added. Applicants set forth remarks relating to the Office Action below.

In the Action, the first Examiner asserted that Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date because no petition was filed with Applicants' late claim for priority. In response, Applicants note that they have submitted a Petition under 37 C.F.R. § 1.78(a)(3) to Correct Priority Information, along with an amended Application Data Sheet and Petition to Correct the Filing Receipt, each indicating the correct priority information. Applicants respectfully submit that these documents correct Applicants' claim to priority.

Further in the Action, the Examiner rejected claims 1-6, 13-19, and 21-24 under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. Pub. No. 2004/143332 to Krueger *et al.* ("Krueger"), and claims 7, 8, and 20 under 35 U.S.C. 103(a) as obvious in view of Krueger. Basically, the Examiner is of the opinion that Krueger teaches each and every limitation of independent claims 1 and 17, and asserted that the apparatus disclosed in Krueger includes a tool part having two tines 242 forming a central pocket therebetween. The Examiner further

asserted that Krueger shows the insertion apparatus assembled with the tines being forward of the shaft distal end and inserted between the baseplates to keep the plates in a substantially parallel orientation to one another and engage corresponding surfaces.

Applicants respectfully submit that independent claims 1 and 17, as amended, are not anticipated by Krueger because the cited reference does not disclose or suggest an apparatus for bringing baseplates of an artificial intervertebral disc substantially parallel to one another in an intervertebral space, wherein tines of the apparatus are spaced and sized to be insertable and fittable between the baseplates such that insertion of the tines into the intervertebral space between the baseplates forces the baseplates into a substantially parallel orientation relative to one another "as the top surface of the at least two tines contacts an inwardly facing surface of one of the at least two baseplates and the bottom surface of the at least two tines contacts an inwardly facing surface of the other of the at least two baseplates." As disclosed in paragraph [00146] of Applicants' originally-filed disclosure, "[E]ach tong's extent has an upper surface 608a-b and a lower surface 610a-b. The upper surface 608a-b is preferably shaped to conform against the inwardly facing surface of a first (e.g., upper) baseplate of an artificial intervertebral disc, and the lower surface 610a-b is preferably shaped to conform against the inwardly facing surface of a second (e.g., lower) baseplate of the artificial intervertebral disc, so that insertion of the forked distal end of the leveler 600 between the baseplates, with the central pocket 606 of the distal end avoiding the central portion of the artificial intervertebral disc, and with the upper 608a-b and lower surfaces 610a-b so engaging the inwardly facing surfaces of the

baseplates, causes the baseplates to be placed in parallel orientation with respect to one another." Amended independent claims 1 and 17 recite that each tine engages the inwardly facing surfaces of adjacent baseplates, while in Krueger, only the top surface of each tine engages an inwardly facing surface of a baseplate. The structure of the insertion tool in Krueger includes two sets of tines as well as specifically shaped inner surfaces of baseplates (namely flat inner surfaces as shown in Fig. 52 of Krueger) in order to effect the orientation of a top baseplate with respect to a bottom baseplate. In contrast, the claimed apparatus only includes one set of tines in order to bring the baseplates of an artificial intervertebral disc substantially parallel to one another.

Therefore, the structure of one set of tines in relation to the structure of the inwardly facing surfaces of the baseplates aids in bringing the baseplates into a parallel orientation, wherein in Krueger, two sets of tines are utilized to force the baseplates into parallel orientation with one another. Accordingly, claims 1 and 17 are not anticipated by Krueger, and are in condition for allowance. Claims 2-8 and 13-16 depending from claim 1 and claims 18-24 depending from claim 17 are also allowable, *inter alia*, by virtue of their dependence from an allowable base claim.

Further, the Examiner has incorrectly characterized Krueger in rejecting the dependent claims in the present application. The dependent claims recite further limitations regarding the structure of the one set of tines in relation to the baseplates of the disc that are not disclosed or suggested in Krueger. For instance, dependent claim 5 recites that the tines are tapered to ease insertion of the at least one of the tines between the base plates. In Krueger, the tines of the insertion tool are flat and are not tapered. See Fig. 43 in

Krueger. As recited in claim 7 (depending from intervening claim 6), the corresponding surface of the disc has a curved contour and the contact surface of the at least one tine has a contour substantially following the curved contour. As stated above, the tines of the insertion tool in Krueger are flat as is the surface of the baseplate that the tines engage (slots 114 shown in Fig. 42). Further still, with respect to dependent claim 8 (depending from intervening claim 6, which depends from independent claim 1) and dependent claim 20 (depending from independent claim 17), Krueger does not disclose or suggest a tine having having a flat upper contact surface and a curved lower surface, the flat upper contact surface of the tine conforming to a flat lower surface of an upper baseplate and the curved lower surface of the tine conforming to a curved upper surface of a lower baseplate. As stated above, the structure of the tines in relation to the structure of the inwardly facing surfaces of the baseplates aids in bringing the baseplates into a parallel orientation, wherein in Krueger, the two sets of tines as well as specifically shaped inner surfaces of baseplates is what makes the baseplates come into parallel orientation with one another.

Applicants respectfully disagree with the Examiner's assertion in the Action, that it would have been obvious to one of ordinary skill in the art to modify the corresponding engagement surfaces of the tines and baseplates of Krueger, since such a modification only involves routine skill in the art, and would not materially affect the operation of the implant. The "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," issued in the Federal Register on October 10, 2007, identify numerous rationales which may be used to support an obviousness

rejection. (See 72 FR 57526, at 57529.) Applicants submit that the Examiner has failed to outline a single rationale relied on in the aforementioned Guidelines in rejecting claims 7, 8 and 20 in view of Krueger. The Examiner instead has relied on assumptions that are not supported by the record. For instance, on page 6 of the Action, the Examiner states, "[t]hus an engineer in developing the implant and tool can easily modify the contours of the tines and baseplates taught by Krueger *et al.* to be flat and curved corresponding surfaces as claimed in claims 7, 8 and 20 since such a coupling of the apparatus keeps them together." Applicants do not understand the statement, "since such a coupling of the apparatus keeps them together." The structure of the tines as recited in independent claim 1 act "such that when the baseplates are substantially non-parallel to one another in the intervertebral space, insertion of the tines into the intervertebral space between the baseplates forces the baseplates into a substantially parallel orientation relative to one another." The Examiner fails to discuss in the Action where in the prior art this claimed feature is disclosed or suggested. As discussed above, Krueger does not teach or otherwise suggest the specific claim features in claims 7, 8 and 20, and the Office Action fails to explain how such features can be obtained from or otherwise achieved by the teachings of Krueger.

Therefore, the Examiner cannot make a *prima facie* case for obviousness of, at least, claims 7 and 8 (depending from claim 1) and claim 20 (depending from claim 16) as Krueger fails to teach or suggest each and every element of these claims. For at least the above reasons, Applicants respectfully request that the obviousness rejection be removed.

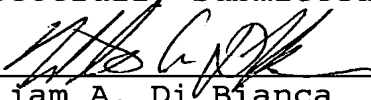
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: January 22, 2009

Respectfully submitted,

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